



# UNITED STATES PATENT AND TRADEMARK OFFICE

112  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,814	12/06/2000	Donald Kyle	332.1114	9564

7590

01/23/2004

Davidson Davidson & Kappel LLC  
485 Seventh Avenue 14th Floor  
New York, NY 10018

EXAMINER
----------

BARTS, SAMUEL A

ART UNIT	PAPER NUMBER
----------	--------------

1621

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,814

Applicant(s)

KYLE ET AL.

Examiner

Samuel A Barts

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14,16,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-5, 7-12,14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 11/26/03 have been fully considered but they are not persuasive. Applicant has addressed the previous office action in two ways.

First, claims 1, 3-4, 7, 11-12, 14 and 16 have been amended to obviate the prior art rejection.

Secondly, applicants have argued that claims 23-24 were not anticipated by the prior art reference of Guryn et al.

Since the examiner does not agree that the Guryn et al reference fails to anticipate claims 23-24 this rejection is still under consideration.

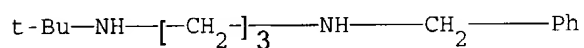
Thus claims 1, 3-4, 7, 11-12, 14 and 16 are withdrawn from consideration since they require further search and consideration in order to determine patentability. The patentability of these claims will be revisited when the issue of patentability with respect to the Guryn et al reference has been finalized.

2. Applicant has argued that claim 23 is not anticipated by Hoffman et al, as this claim does not recite hydrogen as a possible substituent at R<sub>5</sub>. The examiner has taken this argument to be in reference to Guryn et al, since the examiner did not reject claims 23-24 over the reference of Hoffman et al. The argument is found unconvincing with respect the rejection over Guryn et al because claim 23 clearly states the R<sub>5</sub> may be hydrogen. The claim is anticipated when R<sub>4</sub>=bond, R<sub>5</sub>=hydrogen atom, R<sub>1</sub>= C<sub>3</sub> alkyl, R<sub>2</sub>= hydrogen R<sub>3</sub>= C<sub>4</sub> alkyl, and n= 0. The rejection is being maintained

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 23-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Guryn et al (Chem. Abstract 1976:43210, rn 57957-05-8 and 57957-20-7).

Guryn et al disclosed the following compound:



This compound reads on the claims when R<sub>4</sub>=bond, R<sub>5</sub>=hydrogen group, R<sub>1</sub>= C<sub>3</sub> alkyl, R<sub>2</sub>=hydrogen R<sub>3</sub>= C<sub>4</sub> alkyl, and n= 0.

Please note that the pharmaceutical composition claims read on the compound in solution. The HCL salt is disclosed which also reads on pharmaceutically acceptable salts

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

Application/Control Number: 09/730,814  
Art Unit: 1621


Page 4

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 703-308-4630. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johan Richter can be reached on 308-1235. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Samuel A Barts  
Primary Examiner  
Art Unit 1621

s.b.